

This preliminary amendment does not contain any new matter prohibited by 35 U.S.C. section 132. As stated by the United States Court of Customs and Patent Appeals, the purpose of the rule against new matter is “to prevent an applicant under the guides of an amendment from introducing into his application a wholly different invention or changing the construction of a fully disclosed invention or presenting a different or preferred form of the invention.” *In re ODA*, 443 F.2d 1200, 1204 (1971). The test for new matter is not whether there is a change in the disclosure. *Ex parte D*, 27 U.S.P.Q. 2d 1067, 1069 (1993). It is “well settled” that “amendments made be made to patent applications for the purpose of curing defects, obvious to one skilled in the art, in the drawings or written descriptions of inventions...” *In re ODA, supra*, 443 F.2d at 1204.

The test is whether the original application as filed “adequately enabled a person skilled in a subject art to practice the invention as claimed.” *Ex parte D, supra*, 27 U.S.P.Q. 2d at 1069. As stated by the court of appeals in *In re Nathan*, 328 F.2d 1005, 1008 (1964), the question is whether the original disclosure adequately identified the claimed subject matter. Clarifications or changes do not necessarily constitute new matter. *Id.* As explained by the court in *In re ODA, supra*, 443 F.2d at 1204: “Amendments purporting to correct errors or to supply omissions in features which are essential to the operativeness of the invention or the completeness of the disclosure are permissible, if the errors are manifest and were caused by a clerical mistake of the draftsman or unfamiliarity of the inventor with official forms and the proposed corrections do not change the essence of the invention....If the changes necessary to make the disclosed device operative are radical in their nature and constitute a departure from the invention originally disclosed, the are not permissible.”

There are a number of decisions involving the correction of errors in patent applications in the chemical arts. In fact, the appellate court in *Riester v. Kendall*, 159 F.2d 732, 733, (1947) quoting the Board, noted that: “In many chemical processes, formulae and equations cannot be given at all with certainty due to the complexity of the reaction or incomplete knowledge thereof. This fact, however, does not preclude a proper disclosure of a chemical reaction and product. By the same token, an initial error in attempting to explain a reaction should not vitiate a disclosure which does in fact fully teach how to secure and recognize a certain product.” The court concluded that the formulae and equations contained in the patent application were “a gratuitous contribution that was not absolutely essential to a teaching of the invention.” *Id.* The application was held enabled regardless of the errors. *Id.* at 734. In *Ex parte Marsili*, 214 U.S.P.Q. 904, 906 (1979), errors in structural formulae were not new matter on the grounds that the structure was an inherent characteristic of the compounds. In *Ex parte D, supra*, 27 U.S.P.Q. 2d at 1070, changes in DNA sequences were not new matter. *In re Nathan, supra*, 328 F.2d at 1008-1009, the addition of the alpha configuration to a chemical compound was not new matter. In *In re ODA, supra*, 443 F.2d at 1206, the correction of the names of compounds was not new matter.

In this case, all of the errors in the detailed description were inadvertent errors made by one of the inventors in computation, equation balancing, or word processing. See Declaration of Jonathan N. Howarth. The corrections contained in this amendment are not new matter because the original application as filed adequately enables a person skilled in the art to practice the invention. Moreover, none of the errors pertain to essential matter. All but two of the errors are in the discussion of examples. The examples are not necessary to satisfy the enablement

requirement, but are for illustrative purposes only. The methods and compositions of the embodiments of the invention are described in detail in the text preceding the examples. The description sets forth fully how to practice the embodiments of the invention.

The three errors in Prospective Example 1 were computational. They resulted from an incorrect balancing of chemical equation 7. The example does not affect the enablement of the first embodiment. See Howarth's Declaration, paragraph 3.

The errors in Examples 2 through 13 were computational errors made in calculating percent yield. None of these errors affect the enablement of the invention. See Howarth's Declaration, paragraph 4.

There were two word processing errors made in the text of the application on pages 56 and 58. These mistakes occurred when the inventor copied and pasted one portion of text from the document into another place in the document, and inadvertently included a phrase that should not have been included. These mistakes occurred during word processing and do not affect the enablement of the invention. See Howarth Declaration, paragraph 5.

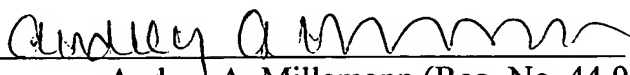
There were several word processing and computational errors made in Examples 14 and 15. The amounts of certain reagents used in the examples were inadvertently left out and the reaction yields were mistakenly calculated. None of these errors affect the enablement of the invention. See Howarth Declaration, paragraph 6.

A word processing mistake was made in the description of the eighth embodiment of the invention, where a phrase was inadvertently omitted. The correction does not affect the enablement of the invention. See Howarth Declaration, paragraph 7.

Accordingly, applicants respectfully request that this preliminary amendment be entered.

Respectfully submitted,

Jonathan N. Howarth and Michael S. Harvey

By:   
Audrey A. Millemann (Reg. No. 44,942)  
Attorney for Applicants  
Weintraub Genshlea Chediak Sproul  
Law Corporation  
400 Capitol Mall, Eleventh Floor  
Sacramento, California 95814  
916/558-6033

Enclosures: Declaration of Jonathan N. Howarth  
Return Card